

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion, in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL McHALE, GEORGE NICHTULA,
CHRISTINE L. CORRIVEAU and WILLIAM J. WOKAS

Appeal No. 1997-2410
Application 08/044,240

ON BRIEF

Before WILLIAM F. SMITH, GARRIS and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 51-54 and 56, and refusal to allow claims 1-6, 8, 15-19, 21 and 28 as amended after final rejection. Claims 7, 9-14, 20, 22-27, 29-50 and 55 stand withdrawn from consideration by the examiner as being directed toward a nonelected invention. These

are all of the claims remaining in the application.

THE INVENTION

Appellants' claimed invention is directed toward multicolored sheeted chewing gum products wherein a sheet or slab of chewing gum has a design of a confectionary material embedded therein. Claims 1 and 51 are illustrative and read as follows:

1. A multi-colored, sheeted chewing gum product with a top and bottom surface, comprising:

a first mass of chewing gum formed in a generally flat sheet; and

a second mass of a confectionery product having a different color than the first mass, smaller than the first mass, and embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product;

the second mass being present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing;

wherein the first mass only is visible from the bottom surface of the chewing gum product;

51. A multi-colored, sheeted chewing gum product, comprising:

a slab of a first chewing gum having a first flat surface and a second surface; and

a rope of a second confectionery material embedded into the slab of first chewing gum;

the rope being present in an undulating pattern;

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wherein the embedded rope of second confectionery material is visible at the first flat surface in said undulating pattern.

THE REFERENCES

| | | |
|---|-----------|---------------|
| Cherukuri et al. (Cherukuri) | 4,971,806 | Nov. 20, 1990 |
| Towae ¹ (German patent application) | 3,516,852 | Nov. 14, 1985 |

THE REJECTIONS

Claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over Towae and also over Cherukuri in view of Towae.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

In response to the examiner's election of species requirement (mailed December 27, 1993, paper no. 3), appellants elected (response filed March 15, 1994; paper no. 6) the product made by the process of example 1 of appellants' specification. The examiner has interpreted this example as producing a product

¹ This reference is referred to by the examiner as "Lorenz". Our consideration of this reference is based upon the English translation thereof which is of record.

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in which the second mass has an undulating pattern (Office action mailed May 10, 1994, paper no. 7, page 4; examiner's answer, page 7).

Appellants argue that the election of species requirement was improper because the examiner did not set forth a proper basis for the requirement, and further argue that the examiner improperly withdrew from consideration some claims which are directed toward the elected species (brief, pages 6-13). The propriety of the restriction requirement and the examiner's grouping of claims in response thereto are petitionable issues rather than appealable issues and, therefore, are not before us for consideration. See *Manual of Patent Examining Procedure* § 1002.02(c)(2) (7th ed., July 1998). Thus, we limit our consideration to the rejected claims. Although appellants' claim 1 recites a number of patterns in which the second mass can be present, we consider only the undulating pattern to which, the record indicates, the examination was limited. See *Ex parte Ohsaka*, 2 USPQ2d 1460, 1461 (Bd. Pat. App. & Int. 1987). We need to address only the independent claims, which are claims 1 and 51.

Rejection over Towae

Towae discloses an extruder for extruding materials which are semifluid when processed warm, such as chewing gum pastes, to make products having multiple colors and shapes (pages 3-4). The portion of the reference relied upon by the examiner is figure 7 which shows twelve cross sectional shapes which can be formed using the extruder (pages 7 and 13).

Regarding claim 1 the examiner argues that the fifth and sixth square gums shown in Towae's figure 7 have a first mass which is a generally flat sheet, a second mass which is visible from one side of the sheet, and a third mass, separate and distinct from the second mass, which is visible from the other side of the sheet (answer, page 6).² Appellants argue that Towae's square gums are too thick to be characterized as sheets and that the second mass is visible from opposite sides of the squares (brief, pages 15-16). The examiner responds that one could modify the extrusion process for producing the fifth pattern such that the second mass is extruded on only one surface, or could cut the first mass horizontally just below the

² The examiner does not state which of the patterns in figure 7 the examiner considers to be the fifth and sixth patterns. It appears from the examiner's argument that the fifth and sixth patterns referred to by the examiner are the middle and lowest patterns in the second column of patterns in the figure.

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top second mass so that the top second mass is visible from the top and not from the bottom (answer, page 11).

The examiner's arguments are not well taken because the examiner has provided no evidence that square gums such as those of Towae were considered in the art to be flat sheets or that the reference would have led one of ordinary skill in the art to modify the extrusion process or cut the gums as proposed by the examiner. In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

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Moreover, the examiner has not explained why Towae would have led one of ordinary skill in the art to form an undulating pattern of the second mass as required by both claims 1 and 51. As pointed out by appellants (brief, page 15), Towae's coextrusion process produces stripes which are parallel to the length of the products. The examiner argues that a person at home could produce an undulating pattern with a rolling pin and a knife (answer, page 7). This is not a convincing argument because the examiner has not explained why one of ordinary skill in the art would have been led by Towae to substitute a rolling pin and knife for his extruder. The examiner argues that it would have been obvious to one of ordinary skill in the art to modify the second mass such that it has an undulating pattern because such a person was "fully aware that consumers take pleasure in consuming confections of various designs" (answer, page 7). This argument is not persuasive because the examiner has not explained why, even if one of ordinary skill in the art desired an undulating pattern, such a person would have been enabled by Towae to modify the extruder such that it produces an undulating pattern. Appellants argue that because Towae's extrusion die is fixed, it is not possible to oscillate one of the streams relative to the other such that an undulating pattern

is formed (brief, pages 24-25). This is a plausible argument which has not been rebutted by the examiner with evidence or technical reasoning.

For the above reasons, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness over Towae of the invention recited in any of the rejected claims.

Rejection over Cherukuri in view of Towae

Cherukuri discloses a multilayered chewing gum in which one layer has a high initial flavor release and the other layer has a longer lasting flavor release (col. 1, lines 15-18). The gum layers are formed by conventional methods such as coextrusion or roller pressing (col. 2, lines 31-32). In one embodiment, ropes of gum are braided and rolled into sheets (col. 9, lines 42-45).

The examiner argues that Cherukuri's table III shows first layers having different colors from second layers, and argues that since a multicolored design is viewable by the consumer (col. 2, lines 66-68), one of the layers must be larger than the other layer (answer, page 9). This argument is not persuasive because Cherukuri merely discloses that conventional techniques are used to laminate layers together. The examiner has not established that the teaching that the multicolored design is

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viewable would have indicated to one of ordinary skill in the art that one layer is smaller than the other rather than indicating that there are two conventional equal sized layers having different colors which are viewable sequentially or from the side.

The examiner argues that forming a design of one of Cherukuri's layers would have been obvious to one of ordinary skill in the art in view of Towae (answer, page 9). This argument is not convincing because the examiner has not explained why Cherukuri and Towae would have led one of ordinary skill in the art to form an undulating design of one layer embedded in another and would have enabled such a person to do so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient for supporting a conclusion of obviousness over Cherukuri in view of Towae of the invention recited in any of the rejected claims.

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DECISION

The rejections of claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 under 35 U.S.C. § 103 over Towae and over Cherukuri in view of Towae are reversed.

REVERSED

William Ford

WILLIAM F. SMITH
Administrative Patent Judge

BRADLEY R. GARRIS

BRADLEY R. GARRIS
Administrative Patent Judge

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